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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,564	04/19/2004	Richard Thiele JR.	THL-10002/29	3187
25006 7590 10/08/2009 GIFTORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C PO BOX 7021 TROY, MI 48007-7021				
EXAMINER KRAMER, DEAN J				
ART UNIT		PAPER NUMBER		
3652				
MAIL DATE		DELIVERY MODE		
10/08/2009		PAPER		

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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD THIELE, JR.

Appeal 2009-003406
Application 10/827,564
Technology Center 3600

Oral Hearing Held: September 15, 2009

Before WILLIAM F. PATE III, STEFAN STAICOVICI and KEN B. BARRETT, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

JOHN POSA, ESQUIRE
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The above-entitled matter came on for hearing on Wednesday, September 15, 2009, commencing at 8:57 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Christine L. Loeser, Notary Public.

PROCEEDINGS

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JUDGE PATE: Why don't you go ahead and introduce yourself?

MR. POSA: My name is John Posa. I am the attorney of record in this case and I have with me the inventor, Richard Thiele.

JUDGE PATE: You can't see our name plates. We have got Judge Barrett, Judge Staicovici and Judge Pate and I'll be presiding and we are on the record now.

MR. POSA: What is your name?

JUDGE PATE: Judge Pate, P-A-T-E.

MR. POSA: Okay. Thank you.

JUDGE PATE: We are up to speed on the technology here and we would like to hear your arguments concerning the patentability.

MR. POSA: Okay. Very good. There were four grounds of rejection set forth in our Brief.

The 112 was merely perfunctory to add the word "blade" or something like that. I won't even address it, if and when this case gets allowed. It only relies upon antecedent basis from claim 1 anyway. Okay?

JUDGE PATE: Go ahead.

MR. POSA: Let's talk about claim 1, all right?

We are talking about a shovel here. This is not, for lack of a better expression, rocket science. It's a predictable art, not to mean that you necessarily have predictable results with these various designs.

I debated whether I should even use the word predictable this morning, but let's face it. This is a predictable art. This is not chemistry or something that requires undue experimentation.

1 We have had a rigorous prosecution here. I mean, this has been going
2 on for many years. There have been other attempts to bring it to the Board's
3 attention. Only today did we finally succeed in doing that and we appreciate
4 you being in attendance here for that.

5 There have been many references cited. We have all done searches. I
6 have done more than one. The Patent Office has done its own. There are a
7 lot of shovels out there. There has been a lot of art cited.

8 I think a fact we can rely on is that my client's invention has not been
9 found in the prior art, which is evidenced by the fact that we are not sitting
10 on a 102 rejection.

11 We have a 103 here. The primary reference is old. This is the Hicks
12 reference. It's basically a piece of wood with this strip of iron tacked on to
13 the front. It's a very old snow shovel, and it has these trapezoidally-shaped
14 front ends which the Examiner acknowledges the shape of. That is of record
15 that they have straight sides and so forth.

16 Hicks, there's a couple of important parts of Hicks that I want to bring
17 to your attention.

18 First of all, this is old-fashion patent, all right, but the claim is for that
19 design which is substantially as shown and described, all right. So Hicks is
20 relying on the drawing which, I mean, archaically, that's what we did.

21 Around lines 43 to 45, Hicks states that the front portion of this tool
22 has a series of cutting edges or plows. I think this is the important part,
23 which will readily enter into and break up the compact snow and ice.

24 Now, I don't know how much Hicks experimented. My client
25 experimented.

1 My client actually made some -- he was dissatisfied with the snow
2 shovel having a straight front edge. It wouldn't break up the snow right. He
3 came up with the design. It's in Chicago. I asked him to bring it today. I
4 couldn't show it to you.

5 He took a grinder and he made some things that -- he found, my client
6 found something that worked and he described it to me, we disclosed it, we
7 claimed it and here we are.

8 Hicks did the same thing. Hicks came up with the design as shown
9 and described here, apparently satisfied with what he came up with because
10 he says right here, it will readily do the job that he had intended it to do.

11 The Examiner acknowledges that this isn't what my client is
12 describing or claiming. It's different, but she or he, the Examiner changed,
13 actually, has made a 103, combining references.

14 Vogel is one of them, Dawley is another. Her argument is that, you
15 know, you should modify Hicks because it will do a better job. Basically,
16 that's her argument. I mean, I don't have to quote her because that's exactly
17 what we've been fighting for the last five years.

18 Who says so? I mean, that's not -- you can start off with a straight
19 shovel with a flat front end and you could make the argument that my
20 client's new invention does a better job.

21 We would agree with you, okay, but Hicks thinks -- Hicks thought
22 that his was just fine. He's didn't -- he is teaching away from any
23 modification. His point of novelty is the very trapezoidally-shaped design
24 that you see in the drawing with the straight edges.

25 Why modify that? But for my client's invention, why modify that?

1 I will also point out that in our case, as is the case of Hicks, the front
2 end is generally perpendicular to the axis of the handle. I mean, it's meant
3 for certain purposes, snow shovelling, for example.
4 Notice in Vogel and Dawley, that is not the case. In Vogel, the business end
5 of this thing, actually there are two. I mean, this is a side.

6 It's not perpendicular. It's parallel to the handle, for what it's worth
7 and, in the case of Dawley, it's at an angle with respect to the handle.

8 I understand that the Examiner was attempting to import these
9 teachings, not for the limitation having to do with perpendicularity, but it's
10 important to remember throughout this prosecution, there's been talk of how
11 well something works for a certain application. It's been around about
12 effectiveness.

13 If you were to combine Hicks with something that has scallops, I
14 think you have to pay attention to the way in which those scallops are
15 oriented in the secondary references. You can't make the argument that you
16 can import these designs and give them to Hicks and say that they will work
17 better if they are not even configured the same way. They are just not.

18 So apart from the fact that there's no motivation, there's no rationale
19 for combining these. Even if they were combined, in essence, my client's
20 invention would not result. Apart from this effectiveness argument, I'm
21 talking structure which is what it's all about.

22 This is not a method claim. These are not method claims. We are not
23 talking about functionality here, we are talking about structure.

24 If I move on to claims 2 to 5, in my opinion, these claims have
25 essentially been overlooked and, in this case, I would like to quote the
26 Examiner if I can find it. And even if I can't, I remember language having to

1 do with all of these particular geometric configurations being obvious
2 because they would better suit the job on hand.

3 I can't find it right now, but these claims weren't really examined.
4 There has been -- the argument was, well, you know, it's pretty obvious to
5 configure them whatever way you want because depending upon the job,
6 you might want to have this radius equal to that diameter or what have you,
7 all right.

8 We disagree. I mean, it's just not true. In fact, if you go to our
9 specifications, my client ground down the front end of a shovel to find out
10 how well it worked. This particular application had to do with snow and ice
11 shoveling.

12 If these scallops are too deep, they leave little rows of snow and ice,
13 for what it's worth. So he found that a shallower scallop is a better way to
14 go. Not only do you get better break-up of the snow and ice but you don't
15 get these little furrows of snow and ice left over.

16 So you get the best of both worlds if you have a bunch of forward
17 points and if you have shallow scallops.

18 Well, the claims that set forth the geometries, particularly the claims
19 3, 4 and 5, that's what they have to do with. Claim 3 means that it's not a
20 hemisphere. It's less than. If you go through the math, that's what it means.
21 When R is greater than D over 2, it means that the point of the radius is
22 pushed out forward of the tool and the scallop is shallower than a
23 hemisphere.

24 Claim 4 is even shallower because now, it is equal to -- R is
25 substantially equal to D . And claim 5, it's shallower yet because it's greater
26 than that.

1 I'm just bringing this up to point out that these are not just nebulous
2 geometries with no meaning or effectiveness. They are not only discussed in
3 the specification, but they are set forth for a reason, having to do with what
4 gets left behind when you use the tool.

5 Then finally, there are some claims having to do with the scoop
6 portion and we rely, I guess we rely on the understandings that one of skill
7 in the art would have with respect to a term such as that.

8 Also, if you look at our drawings, it is pretty clear. We don't have a
9 side view but it's pretty clear that what we mean by scoop is something that
10 has a scoop.

11 MR. THIELE: Some dimension to it, yeah.

12 MR. POSA: Yeah. The term speaks for itself. It's not a board. I
13 think there's a very good argument to be made that given a claim term, I
14 mean, we are cognizant of the fact that the Office can interpret a term with
15 its broadest reasonable interpretation, certainly. I have been through this so
16 many times.

17 There's breadth and then there's reasonableness. I mean, I think it is
18 just, you stretch things to the breaking point when you call a board a scoop.
19 Again, it's not the function that it performs. Even if the Board were to have
20 some sort of a scooping action, that's not what we are talking about. We are
21 not talking about a step of a method. We are talking about a thing. My
22 argument is that if you tap the person of skill on the art -- skill in the art on
23 the shoulder and hand them a piece of wood and say, What do you think, is
24 this a scoop?

25 What do you think they would say? They would say no, it's not.

1 That has to do with the third grouping of claims on the merits, our
2 section D, having to do with the Hicks-Dawley or Hicks-Vogel
3 combinations and further in view of this Johnson reference.

4 Do you have anything to ...

5 MR. THIELE: Other than when we first came up with this, the
6 thought of the whole piece was I had a shovel that had flat front to it, and as
7 I was trying to just remove snow off my driveway, it became apparent that
8 there was a better way to do it.

9 I took the shovel, tried a few different options. One of them originally
10 was let's try some points, thinking that would be the best way. It didn't -- it
11 always left residue behind and that's why I actually took a shovel and started
12 grinding down into scallops to figure out which would be the best way to
13 work.

14 And ultimately designed and came up with, which is what are in the
15 drawings, is a shallower scoop that had the forward leading edge and a point
16 so it would slide through it.

17 I couldn't believe that it made such a big difference, and I think back
18 to, my wife came out there and I was showing her, Here, you try it, make
19 sure it works. We had two shovels, one with a flat edge versus this one and
20 went over the same thing. She did the same thing and was surprised at how
21 much easier it was.

22 I just think everything we have seen from my opinion, I guess, it just
23 seems different than what we had put out there. So I really feel that we had
24 something unique here and that's why, I guess that's why I have been staying
25 with this for over five years.

1 It's not something -- everything that has come back to us, it's one way
2 of looking at it but it's not what we even intended. So that's why we are here
3 today, I guess. I appreciate your time.

4 MR. POSA: Does the Board have any questions?

5 JUDGE STAICOVICI: Yes. I have a quick question. I was looking
6 through the Examiner's Answer and he really doesn't say that it's going to be
7 better by changing the blade. It just says the functional equivalent.

8 MR. POSA: I'm sorry. Where in the Examiner's Answer are you
9 looking?

10 JUDGE STAICOVICI: Page 4 around, line, 5, 6 from the top.

11 MR. POSA: Well, I'm sorry. Hang on a second. Give me a second
12 here. All right. Page 4.

13 JUDGE STAICOVICI: Right at the top, second paragraph.

14 MR. POSA: Well, that's part of the same phrase. I mean, I don't mind
15 you finding that. Functionally equivalent and then a reason is given.

16 JUDGE STAICOVICI: If it's functionally equivalent, wouldn't that
17 be just a simple replacement in view of KSR?

18 MR. POSA: No. We are talking about structural differences here. If
19 there had been some experiments done by my client or by the Patent Office
20 or, I mean, I understand the Patent Office doesn't conduct experiments.
21 But if there were some data in the prior art to prove this out, well, we
22 wouldn't be here.

23 I mean, anybody can say that something is a functional equivalent. A
24 shovel with a flat front edge, if the only function we are talking about is
25 lifting something off the ground, not caring what it is, I guess you could
26 make a stretch and say, well, there is a functional equivalent there.

1 We are talking about a particular geometry of the front edge. I don't
2 think functional equivalent comes into this. We define it in a certain way by
3 points, forward edge, parts of circles. We have done our best to make it
4 structural, at least in claim 1.

5 Now, you go and say it is functionally equivalent to better penetrate --
6 you know what? In fact, to say that it does a better job goes beyond
7 functional equivalency, doesn't it? I mean, it's not functional equivalent
8 anymore. She is saying it is better now.

9 I mean, this is all mixed up. This is not, we are not, this is not a
10 method claim. There's no data or evidence in the prior art to prove this out;
11 therefore we should be entitled to our structure.

12 JUDGE STAICOVICI: Thank you.

13 MR. PATE: I don't think we have any more questions for you. Thank
14 you for your argument. We are going to take this case under advisement.

15 MR. POSA: Thank you very much.

16 MR. THIELE: Thank you. I appreciate it.

17 (Whereupon, the proceedings, at 9:15 a.m., were concluded.)